

## REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claim 1 has been amended to make editorial changes, in order to better comply with U.S. practice. Claims 2 and 3 have been cancelled, without prejudice. No new matter has been added to the application by these amendments.

The patentability of the present invention over the disclosure of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Ojima et al. (U.S. 4,581,452) is respectfully traversed.

MPEP 2121.02 states that where a process for making a compound is not developed until after the date of invention, the mere naming of a compound in a reference, without more, cannot constitute a description of the compound. *See In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). Although Ojima et al. literally disclose pentafluoroethyl and alpha-pentafluoroethyl acrylic acid, the reference fails to teach or suggest the preparation methods or physical properties of the compounds. The reference discloses the respective physical properties and preparation methods of perfluoromethyl and perfluoropropyl, but not those of pentafluoroethyl. In other words, alpha-pentafluoroethyl acrylic acid and its esters were unknown compounds even after the publication of U.S. 4,581,452. Thus, this situation falls under MPEP 2121.02, because the present invention showed the physical properties and preparation methods of alpha-pentafluoroethyl acrylic acid and its esters for the first time. See page 1, line 14 to page 2, line 14 of Applicants' specification.

For these reasons, the invention of claim 1 is clearly patentable over Ojima et al.

The rejection of claim 2 under 35 U.S.C. § 102(b) as being anticipated by Ojima et al. (U.S. 4,581,452) has been rendered moot by the cancellation of claim 2.

The rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Ojima et al. (U.S. 4,581,452) in view of De Castro Loureiro Barreto Rosa et al. (U.S. 6,103,927) has been rendered moot by the cancellation of claims 2 and 3.

The provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 6, 7 and 9 of Miyazawa et al. (U.S. 6,784,312) is respectfully traversed.

The claims of Miyazawa et al. intentionally encompass alpha-pentafluoroethyl acrylic acid esters. However, similar to the discussion regarding Ojima et al. above, Miyazawa et al. fail to teach or suggest the preparation methods or physical properties of alpha-pentafluoroethyl acrylic acid esters. The physical properties and preparation methods of alpha-nonafluoro-n-butyl acrylic acid esters and alpha-trifluoromethyl acrylic acid esters are disclosed in this publication, but not those of pentafluoroethyl. Further, alpha-nonafluoro-n-butyl acrylic acid and alpha-trifluoromethyl acrylic acid, both serving as raw materials, have been known before the filing date of Miyazawa et al. On the contrary, the physical properties and preparation methods of alpha-pentafluoroethyl acrylic acid esters are not described in this publication, since alpha-pentafluoroethyl acrylic acid serving as a raw material was an unknown compound at that time. In other words, the alpha-pentafluoroethyl acrylic acid esters were unknown compounds even after the publication of Miyazawa et al. (U.S. 6,784,312). Thus, this situation falls under MPEP 2121.02 (cited above), because the present invention showed the concrete physical properties and preparation methods of alpha-pentafluoroethyl acrylic acid esters for the first time.

For these reasons, the invention of claim 1 is clearly patentable over Miyazawa et al.

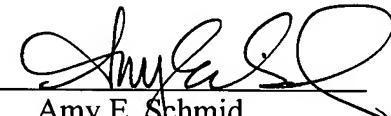
The provisional rejection of claims 2-3 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending application 10/550,387 has been rendered moot by the cancellation of claims 2 and 3.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, the Examiner is respectfully requested to contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

Kenji TOKUHISA et al.

By: 

Amy E. Schmid  
Registration No. 55,965  
Attorney for Applicants

AES/nrj  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
August 14, 2007